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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/689,172

10/20/2003

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07/13/2006

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EXAMINER

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ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/13/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/689,172
Filing Date: October 20, 2003
Appellant(s): LUNSFORD ET AL.

MAILED
JUL 14 2006
GROUP 1700

Thomas M Spielbauer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 8, 2006 appealing from the Office action mailed October 28, 2005 in light of the Advisory Action mailed January 6, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 4,816,333	Lange et al	3-1989
US 2003/0152768 A1	Melancon et al	8-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 and 29-37 are rejected under 35 USC 103(a) as being unpatentable over Lange et al, taken either individually, or for claims 6 and 32 in view of Melancon et al. Lange et al, a commonly assigned patent, discloses (note particularly Figure 1, Col 2, lines 35-57, Col 3, lines 20-32, lines 47-51, Col 4, lines 5-9, Col 5, lines 1-15, lines 28-40, the Examples) a very closely related genus of articles which can comprise a variety of suitable polymeric substrates such as polyester (Col 3, lines 47-51, Col 4, lines 5-9) which may be primed by a layer of silica nanoparticles that are formed in a gelled network which is firmly believed to read upon appellants' claim language wherein the independent claims state that "the primer consists essentially of nanoparticles". Additionally note (Col 4, lines 5-9) that the primer functions as one of ordinary skill would expect in "adhering adhesives to substrates, such as polymeric substrates, e.g. polyester film", and also note that one of appellants' most preferred trademark identified compositions, NALCO 2326 (see spec, page 12, lines 8-11, Examples) is also utilized as a preferred colloidal silica in Lange et al. Note that appellants' claims restricts the primer to "consists essentially of nanoparticles", and although at Col 6, lines 1-10, particularly lines 1-2 the reference states that the coating ingredients may "optionally" contain a polymeric binder, binders, of course are not required to be present. Returning to the adhesive layer it is noted that although the only specific adhesive composition (which appears to be inherently taught) in Lange et al is Example 1's wherein the utilization of the adhesive layer found on 3M's trademark only identified Scotch Brand

Art Unit: 1771

Magic Tape is believed to be an acrylic pressure sensitive adhesive, there still remains the previously referred to disclosure of Col 4, lines 5-9 specifically stating that excellent results are obtained when using the disclosed primer to adhere "adhesives" to e.g. polyester films, and note also that while appellants' claims are argued as having excluded the acrylic psa's utilized in these trademark identified embodiments **they simply do not exclude any other types of adhesives of which the Examiner is aware, i.e. appellants' claims are very broad with respect to the claimed adhesive.**

The Examiner also notes that the process of making the claimed genus of articles involves forming a coating of the primer, which is believed to be clearly disclosed by the reference, and as to the rejection of claims 6 and 32 in view of Melancon et al note (e.g. the Abstract) that the reference teaches the use of silicone polyurea based adhesives, together with the fact that appellants have based their traversal of the prior art rejections of record of both these and the remaining dependent claims on the alleged flaws of Lange et al.

(10) Response to Argument

The Examiner has little to note to what has been set above, but wishes to again point out that appellants' arguments (e.g. Brief, page 7) that the reference is fatally flawed because it fails to point out a single adhesive composition save for the trademark only identified acrylic compositions in the test tape have failed to appreciate several fundamental points. These are 1) the disclosure in Lange et al, particularly of Col 4, lines 5-9, wherein it is clearly taught that the reference primer is very suitable as a primer for adhering adhesives to substrates, with no restriction whatsoever on the

Art Unit: 1771

type of adhesive used; 2) the ordinary skill of the art which is more than well aware that primers are commonly utilized to improve the bonding of a coated on adhesive layer to a desired substrate; and finally 3) that fact that appellants' claims encompass virtually every adhesive known as being suitable for use except a small genus of acrylic acid unit containing species all must lead to the fact that an overwhelming **prima facie** case against the pending claims has been presented and not rebutted. Finally, it is also noted that appellants spend a significant amount of time and effort arguing against a reference (EP '756) which they admit is no longer relied upon by the Examiner to reject any of the claims. In summary, appellants have failed to rebut the **prima facie** case of record.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Daniel Zirker



Conferees:

Terrel Morris - FM

Carol Chaney - CC